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Applicant : Atsushi FUKUI et al.
Filed : December 23, 2004
TC/A.U. : 1795
Examincr : Cynthia K. Lee
Dkt. No. : MAM-056
Cust. No. : 20374

Confirmation No. 7337

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1. REPLY BRIEF

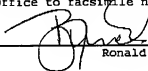
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BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ronald J. Kubovcik

REPLY BRIEF

Ex parte Atsushi FUKUI et al.

NEGATIVE ELECTRODE FOR LITHIUM SECONDARY CELL
AND LITHIUM SECONDARY CELL

Serial Number: 10/519,073
Filed: December 23, 2004
Appeal No. : (Not yet assigned)
Group Art Unit: 1795
Examiner: Cynthia K. Lee
Dkt. No. MAM-056

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/519,073 Confirmation No. 7337
Applicant : Atsushi FUKUI et al.
Filed : December 23, 2004
TC/A.U. : 1795
Examiner : Cynthia K. Lee
Dkt. No. : MAM-056
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REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 29, 2008

Sir:

This Reply Brief responds to the Examiner's Answer dated October 29, 2008, in the appeal to the Board of Patent Appeals and Interferences in the patent application identified above. In particular, this Reply Brief responds to the points of argument of the Examiner in the Examiner's Answer explained below.

(1) On page 9, second full paragraph, the Examiner states:

"The mechanical properties recited in claim 2 for the current collector are deemed to have been met by a process in which a surface roughened copper foil current

collector and the binder are sintered below the decomposition temperature and above the melting temperature of the binder."

This statement is not correct and constitutes an improper shift to the appellant of the Examiner's initial burden of supporting a case of prima facie obviousness. That the statement is wrong is evidenced by the data in the application and, in particular, by the data of Tables 12 and 13 of the application. Current collectors a7 and b2 identified in these tables are both an electrolytic copper foil having the same thickness and the same surface roughness. Current collector b2 is heat treated at a temperature that is above the glass transition temperature of the binder used in Experiment 8 (148 °C) but below the decomposition temperature. Current collector b2 has an elongation of break that falls outside the scope of the present invention. On the other hand, current collector a7, which was heat treated under the same conditions as current collector b2 and was additionally heat treated at 400 °C for 10 hours, had properties falling within the scope of the present invention.

These data show that the properties of the current collector depend on the conditions of heat treatment and that treatment at a temperature that is above the glass transition temperature but

below the decomposition temperature of the binder will not necessarily result in a current collector that meets the limitations of the claims.

Appellant notes that the data of Tables 12 and 13 of the application are of record in the application and are not new evidence prohibited under 37 C.F.R. § 41.41

(2) In response to the argument beginning in the last line on page 6 of the Appeal Brief that the comparative data in the application demonstrate the materiality of the mechanical properties of the current collector and of the mechanical properties of the binder of the active material layer of the negative electrode of the present invention in obtaining unexpected superior charge-discharge cycle characteristics, the Examiner states:

"It is noted that the Applicant is not arguing the non-obviousness of the combination of the prior art, but the non-obviousness of the mechanical properties. It is the Examiner's position that it is an inherent property existing [in, sic?] the combination of references."

(Examiner's Answer, page 11, last paragraph). (Emphasis appellant's).

U.S. Patent Appln. S.N. 10/519,073
REPLY BRIEF

The Examiner's position is not correct because it amounts to a comparison of the negative electrode of the present invention with the negative electrode of the present invention, i.e., a comparison of the negative electrode of the present invention with a negative electrode suggested by the Examiner's combination of references and that does not exist in the prior art. MPEP § 716.02(e)(III) explains the impropriety of such a comparison as follows:

"Although evidence of unexpected results must compare the claimed invention with the closest prior art, applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987) (Newman, J., concurring) (Evidence rebutted prima facie case by comparing claimed invention with the most relevant prior art. Note that the majority held the Office failed to establish a prima facie case of obviousness.); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966) (Requiring applicant to compare claimed invention with polymer suggested by the combination of references relied upon in the rejection of the claimed invention under 35 U.S.C. 103 "would be

U.S. Patent Appln. S.N. 10/519,073
REPLY BRIEF

requiring comparison of the results of the invention with the results of the invention." 357 F.2d at 422, 148 USPQ at 714.).

For these reasons, the Examiner has failed to properly support a case of obviousness of the claims of the present application under 35 U.S.C. § 103(a) and has failed to give proper consideration to the comparative data in the application.

Reversal of the 35 U.S.C. §103(a) ground of rejection is in order and is respectfully solicited.

In the event that any fees are required in connection with this paper the Commissioner is authorized to charge Deposit Account No 111833.

Respectfully submitted,

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